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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/802,959 | 03/12/2001 | Hiromichi Nakata | 10517/88 | 4861 |
| 7590 10/15/2003 | | | EXAMINER | |
| John C. Altmiller Kenyon & Kenyon Suite 700 1500 K Street, N.W. Washington, DC 20005-1257 | | | DOVE, TRACY MAE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1745 | |
| DATE MAILED: 10/15/2003 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,959

Applicant(s)

NAKATA ET AL.

Examiner

Tracy Dove

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,15-17,21-25 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11,15-17,21-25 and 30 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers filed on 7/2/01 under 35 U.S.C. 119 (a)-(d) based on an application filed in Japan on 3/2/01 (2001-058173). Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

Receipt is acknowledged of papers submitted on 3/12/01 under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file (Japanese documents 2000-068553 and 2000-169897). These two Japanese documents are acknowledged in the declaration.

Allowable Subject Matter

Claims 1-11, 15-17, 21-25 and 30 are allowed.

The following is an examiner's statement of reasons for allowance: the claims are directed toward a fuel cell gas separator formed from a metal that is coated with a first noble metal layer and a second carbon layer on the noble metal layer.

The prior art does not teach the claimed fuel cell gas separator. Yoshimura teaches a fuel cell gas separator that is coated with a first metal layer such as tin and a second carbon layer on the metal layer. Yoshimura teaches in the background that it is known in the art to coat the fuel cell gas separator with gold (noble metal). However, gold is used because of its high corrosion resistance property (col. 1, lines 37-42). Yoshimura teaches that the separator achieves high corrosion resistance due to the carbon material coating (col. 7, lines 32-35). Thus the carbon

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material and the gold (noble metal) are corrosion resistant materials. The tin is used to improve the electrical conductivity of the separator. Thus one of skill in the art would have been motivated to substitute the gold layer for the carbon layer in Yoshimura. One of skill in the art would not have been motivated to substitute a gold layer for the tin layer of Yoshimura because they have different properties (corrosion resistance and/or electrical conductivity). The gold layer and the tin layer are not functional equivalents.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is (703) 308-8821. The Examiner may normally be reached Monday-Thursday (9:00 AM-7:30 PM). My supervisor is Pat Ryan, who can be reached at (703) 308-2383. The Art Unit receptionist can be reached at (703) 308-0661 and the official fax numbers are 703-872-9310 (after non-final) and 703-872-9311 (after final).

October 10, 2003


Patrick Ryan
Supervisory Patent Examiner
Technology Center 1700